

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

TESSERA, INC.,	§	
	§	
Plaintiff,	§	
v.	§	CIVIL ACTION NO. 2-07-CV-143-TJW
	§	
MOTOROLA, INC., QUALCOMM, INC., FREESCALE SEMICONDUCTOR, INC., and ATI TECHNOLOGIES, INC.	§	
Defendants.	§	

MOTION TO STAY PURSUANT TO 28 U.S.C. § 1659

Defendants Motorola, Inc., QUALCOMM Inc., Freescale Semiconductor, Inc., and ATI Technologies ULC, hereby move this Court for a stay pursuant to 28 U.S.C. § 1659. In support of their motion, Defendants respectfully state:

This action was filed on April 17, 2007 alleging infringement of two patents: U.S. Patent No. 5,852,326 ("the '326 patent") and U.S. Patent No. 6,433,419 ("the '419 patent"). On the same day it brought this action, Plaintiff also filed a Complaint Under Section 337 Of The Tariff Act Of 1930, As Amended before the International Trade Commission and asked the Commission to commence an investigation under Section 337 ("the ITC Proceeding") against Defendants and others. In the ITC Proceeding, Plaintiff asserts infringement of the same two patents at issue in this case. The ITC instituted an investigation, No. 337-TA-605, on May 16, 2007. *See Exhibit A* (attaching the letter Freescale received; all other Defendants received the same letter).

Upon the request of any party to a civil action that is also a respondent in an ITC investigation, the Court "shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission." 28 U.S.C. § 1659(a). This stay is mandatory and must

be granted if it is made within thirty days from the later of (1) the party being named a respondent in a proceeding before the ITC, or (2) the filing of the district court action. 28 U.S.C. § 1659(a)(1)-(2); *see also In re Princo*, 478 F. 3d 1345, 1355 (Fed. Cir. 2007) (granting a writ of mandamus and directing a district court to stay proceedings pursuant to 28 U.S.C. § 1659(a) until the ITC proceeding becomes final).

Plaintiff alleges infringement of the '326 patent and the '419 patent in both the ITC Proceeding and this parallel District Court action. Accordingly, the issues are the same between this action and the ITC investigation. The ITC published its Notice of Investigation on May 21, 2007, in which Defendants were named respondents by the Commission. *See Exhibit B*. Thus, this motion has been filed within thirty days of Defendants being named as respondents in an ITC proceeding.

Defendants spoke with Plaintiff's counsel on both June 11 and June 13, 2007 about Defendants' intent to file this motion, however, counsel did not indicate whether Plaintiff would oppose the motion.

For all the foregoing reasons, Defendants respectfully requests that the Court stay this action pursuant to 28 U.S.C. § 1659(a). A proposed Order granting this unopposed Motion is submitted herewith for the Court's convenience.

Dated: June 14, 2007

Respectfully submitted,

/s/ David L. Witcoff

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CLI-1,522,360

CERTIFICATE OF CONFERENCE

The undersigned communicated about this motion with Wesley Hill, counsel to Plaintiff, on both June 11 and June 13, 2007. As of the time of filing this motion, Plaintiff's counsel had not responded whether Plaintiff would oppose the motion.

/s/ David L. Witcoff

CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) this 14th day of June, 2007. Any other counsel of record will be served by facsimile transmission and/or first class mail.

/s/ David L. Witcoff

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Plaintiff,	§	
v.	§	CIVIL ACTION NO. 2-07-CV-143-TJW
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	§	
Defendants.	§	

ORDER ON MOTION TO STAY PURSUANT TO 28 U.S.C. § 1659

Having considered the Motion for Stay, the supporting and opposing papers, the pleadings and papers on file with the Court, and the arguments of counsel, if any, and good cause appearing therefor, the Court **FINDS** that the Defendants in this action are also Respondents in proceeding 337-TA-605 before the United States International Trade Commission involving the same issues involved in this action and that Defendants have timely requested for a stay of the action before this Court in accordance with 28 U.S.C. § 1659.

IT IS HEREBY ORDERED that Defendants' Motion for Stay is **GRANTED**. All proceedings in this action are hereby **STAYED** pending final determination of the United States International Trade Commission.